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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,622	02/25/2002	Koichi Takahashi	1448.1021	8100

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EXAMINER	
DENNISON, JERRY B	
ART UNIT	**PAPER NUMBER**
2143	

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/080,622	TAKAHASHI, KOICHI	
	Examiner	Art Unit	
	J. Bret Dennison	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 March 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *10-25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. This Action is in response to RCE Amendment for Application Number 10/080,622 received on 06 March 2006.

2. Claims 1-9 have been canceled.

3. Claims 10-25 are new.

Claim Interpretation

4. Before a detailed mapping, a brief interpretation of the claimed invention should be made to clarify how Examiner is interpreting the claims. The preambles of the independent claims include the standard functionality/setup of email being sent between clients.

5. For example, a first client, whose email address is an AOL email address, sends an email message to a second client whose email address is a Yahoo email address. The email message is transferred from the first client, through the AOL mail server, which directs the email message to the Yahoo mail server, and the Yahoo mail server directs the email message to the second client.

6. Since this standard functionality/setup is well known, and used across the internet to provide users with the ability to send email to other users on different service providers/mail servers, it is inherent in any prior art emailing system, that this functionality/setup is included.

7. The limitations of the independent claims focus towards one of the mail servers explained above. In their broadest reasonable interpretation, the limitations simply disclose a first mail server receiving a message from a first client, and the first mail

server sending a message to a second mail server, which sends the message to a second client. The detail of the message sent by the first client holds very little patentable weight since all it is doing is simply "indicating" something. Nothing is being performed based on this indication.

8. A reasonable interpretation would be, for example, a first client responds to an email received from a second client, the response being a warning that says, "I don't want email from you." The first mail server receives this response and sends it to the second mail server. Since this "warning message" was addressed to the second client, it causes the second mail server to send the warning message to the second client.

9. Therefore, in their broadest reasonable interpretation, the independent claims simply disclose the basic functionality of sending email. Examiner is required to interpret the claims to their broadest reasonable interpretation, see MPEP 2111.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting

directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 10, 12, 14, 16, 18, 20, 22 and 24 are rejected under 35 U.S.C. 102(e) as being anticipated by Morin et al. (U.S. 6,748,422).

10. Regarding claims 10, 14, 18, and 22, Morin disclosed a mail system that relays email from a first terminal to a second terminal via a first mail server and a second mail server, the first mail server relaying the email from the first terminal to the second mail server, the second mail server relaying the email from the first mail server to the second terminal (inherent in all email systems, see above, claim interpretation), wherein

the second mail server includes:

a receiving unit that receives a notice from the second terminal, the notice indicating that a user of the second terminal rejects email from the first terminal (Morin, col. 6, lines 61-64); and

a transmitting unit that transmits a warning request to the first mail server, the warning request causing the first mail server to issue a warning to the first terminal (Morin, col. 6, line 65 through col. 7, line 5).

Claim 14 includes a mail server with limitations substantially similar to the limitations of claim 10. Claim 18 includes a method with limitations substantially similar to the limitations of claim 10. Claim 22 includes a computer readable recording medium with

limitations substantially similar to the limitations of claim 10. Therefore, claims 14, 18, and 22 are rejected under the same rationale.

11. Regarding claims 12, 16, 20, and 24, Morin disclosed the limitations, substantially as claimed, as described in claims 10, 14, 18, and 22, including wherein the second mail server blocks email that is originated from the first terminal and destined to the second terminal after receiving the notice from the second terminal (Morin, col. 7, lines 10-13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 11, 13, 15, 17, 19, 21, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morin.

12. Regarding claims 11, 15, 19, and 23, Morin disclosed the limitations, substantially as claimed, as described in claims 10, 14, 18, and 22. Morin also disclosed performing actions based on the number of complaints it receives about senders and sending an email message to the sender to notify him of the warnings (Morin, col. 7, lines 5-15). Morin did not explicitly state wherein the transmitting unit

transmits an invoice request to the first mail server when the receiving unit receives the notice at least two times, the invoice request causing the first mail server to issue an invoice to the first terminal. Examiner takes Official Notice (see MPEP § 2144.03) that sending invoices in an email system was well known in the art at the time the invention was made. As an example, Examiner provides the following reference: Guthrie et al. (U.S. 2002/0052841).

13. Regarding claims 13, 17, 21, and 25, Morin disclosed the limitations, substantially as claimed, as described in claims 10, 14, 18, and 22. Morin did not explicitly state wherein the second mail server further includes a calculating unit that calculates a usage fee of the mail system owed to the user of the second terminal so that a penalty paid by a user of the first terminal in response to the invoice is refunded to the user of the second terminal. Examiner takes Official Notice (see MPEP § 2144.03) that calculating usage fees for email in an email server was well known in the art at the time the invention was made. As an example, Examiner provides the following reference: Cacace-Bailey et al. (U.S. 6,508365).

The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also *In re Boon*, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or

argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, *In re Boon*, 169 USPQ 231, 234 states "as we held in *Ahlert*, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure

relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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